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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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00/000,000 00/00/00 DOMINGUEZ DE WALTER

L HDE-94/F-249

EXAMINER

ACQUAH, S

ART UNIT PAPER NUMBER

8

DATE MAILED:

07/31/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 4/29/96

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-29 is/are pending in the application.

Of the above, claim(s) 8, 9, 16-18, 27, and 28 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-7, 10-15, 19-26, and 29 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

BEST AVAILABLE COPY

Serial Number: 08/520,662

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Art Unit: 1207

15. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-7, 10-15, 19-26, and 29, drawn to a process for antimony-free polyester, classified in Class 528, subclass 272.

II. Claims 8, 9, 16-18, 27, and 28, drawn to a process for a polyester derived from a hydroxycarboxylic acid, classified in Class 528, subclass 361.

16. The inventions are distinct, each from the other because of the following reasons:

17. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. (M.P.E.P. § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it is capable of supporting a separate patent. The subcombination has separate utility such as in making polyester fibers or polyurethanes.

Art Unit: 1207

18. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

19. During a telephone conversation with John M. Genova on 7/15/96 a provisional election was made with traverse to prosecute the invention of a process for antimony-free polyester, claims 1-7, 10-15, 19-26 and 29. Affirmation of this election must be made by applicant in responding to this Office action. Claims 8, 9, 16-18, 27, and 28 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

20. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

21. Claims 6 and 8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The claims recite "lower aliphatic ester" of a dicarboxylic acid. As indicated in the previous communication said recitation is confusing. The cited recitation is a lower alkyl ester of a dicarboxylic acid.

22. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 10-15, 19-26, and 29 are rejected under 35 U.S.C. § 102(b) as being anticipated by Horlbeck et al. and Hashimoto et al.

23. Applicant's arguments filed 4/29/96 have been fully considered but they are not deemed to be persuasive.

The cited prior arts are of record in the previous communication and disclose processes for the preparation of polyesters in the presence of catalysts and inhibitor as claimed. Applicants have provided a Table showing the stages of the claimed process and the various catalysts and components utilized. It is herein pointed out that said Table does not show the use of P inhibitor in the polycondensation stage; however, column 6 line 60 of the '601 to Hashimoto et al. clearly shows the use trimethyl phosphate.

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It is Applicants' argument that:

none of the references teaches the distinguishing feature that the cobalt compound, which is added after transesterification, is not completely complexed. Applicants have discovered that a partial deactivation of the cobalt compound surprising leads to a drastic improvement in reproducibility and rates of polycondensation...Therefore, if the claimed process is different, then the claimed polyester product is likewise different from the prior art.

It is herein pointed out that Applicants' arguments are not convincing. First of all, assuming arguendo that the claimed process is different, that does not necessarily make the product different unless Applicants can show that the claimed product does possess characteristics which distinguish said product over those of the prior art. In the case herein Applicants have not carried forth said showing. Secondly, it is the Examiner's position that Applicants' argument of the partial deactivation of the cobalt compound is not convincing. In fact, Applicants have not shown any criticality to the use of the cobalt compound. The cobalt compound is present in the amount of 0-80 ppm. Thus it is an optional ingredient. Also, the complexing agent is added in the amount of 0-99% of the amount of cobalt compound. In essence, Applicants have not distinguished over the disclosures of the prior arts. Said prior arts disclose the use of P and Co in the claimed amounts; they do not disclose the use of antimony. It is the Examiner's position that the prior art disclosures are essentially as claimed.

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24. References listed on PTO-1449 have been made part of the record.

25. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam A. Acquah whose telephone number is (703) 308-2436. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

ACQUAH:jd
JULY 29, 1996



SAMUEL A. ACQUAH
PRIMARY EXAMINER
GROUP 1200